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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Joon Maeng

Serial No.: 09/627,731

Filed: July 28, 2000

Group Art Unit: 2179

Confirmation No.: 2827

Examiner: Mylinh T. Tran

Title: SYSTEM AND METHOD FOR GENERATING INVISIBLE
NOTES ON A PRESENTER'S SCREEN

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated July 14, 2006, with a two-month statutory period for response set to expire on September 14, 2006.

I. RESPONSE TO EXAMINER'S ARGUMENTS

- A. Response to Examiner's argument that Ludwig discloses "displaying said second file only on said primary workstation as an overlay to said first file, wherein said second file is not viewable by said at least one secondary viewer" as recited in claim 1 and similarly in claims 11, 19 and 25, as discussed on pages 10-11 of Examiner's Answer.

The Examiner asserts that Ludwig discloses "displaying said second file only on said primary workstation as an overlay to said first file, wherein said second file is not viewable by said at least one secondary viewer" as recited in claim 1 and similarly in claims 11, 19 and 25. Examiner's Answer, pages 10-11. In particular, the Examiner cites column 36, lines 53-58; and column 36, line 61 – column 37, line 13 of Ludwig as disclosing the aspect of "overlay" in the above-cited claim limitation. Examiner's Answer, page 10. Appellant respectfully traverses.

Ludwig instead discloses that in the course of a videoconference, as illustrated in Figure 36, the field representative shares with the Expert a graphical image 210 of his client's portfolio holdings (by clicking on his SHARE button) and begins to discuss the client's investment dilemma. Column 36, lines 50-59. Ludwig further discloses that after considering this information, reviewing the shared portfolio and asking clarifying questions, the Expert illustrates his advice by creating and sharing a new graphical image 220 with the field representative and his client. Column 36, lines 61-65. Ludwig further discloses that either party to the share can annotate that image using the drawing tools 221 (and the TEXT button, which permits typed characters to be displayed) provided within Share window 211, or 'regrab' a modified version of the original image, or remove all such annotations, or 'grab' a new image to share. Column 36, line 65 – column 37, line 6. Hence, Ludwig discloses an Expert sharing a graphical image with a field representative and his client. Both the Expert and the field representative may annotate the shared graphical image, such as by using text. There is no language in the cited passages that discloses displaying a second file only on the primary workstation as an overlay to the first file. Based on Appellant's understanding, the Examiner is asserting

that the annotations to the shared image (e.g., using the drawing tools to permit typed characters to be displayed) as disclosed in Ludwig discloses an overlay. However, these annotations are not displayed only on the primary workstation. Instead, they are displayed to both the Expert and the field representative. Further, these annotations are not an overlay to the graphical image. Thus, Ludwig does not disclose all of the limitations of claims 1, 11, 19 and 25, and thus Ludwig does not anticipate claims 1, 11, 19 and 25. M.P.E.P. §2131.

Further, in connection with the rejection of the above-cited claim limitation, if the Examiner is asserting that drawing tools 221 of Ludwig constitutes an overlay, Appellant respectfully traverses. Drawing tools 221 is not displayed only on the primary workstation. Neither is drawing tools 221 an overlay to the graphical image. Thus, Ludwig does not disclose all of the limitations of claims 1, 11, 19 and 25, and thus Ludwig does not anticipate claims 1, 11, 19 and 25. M.P.E.P. §2131.

Further, Appellant had cited to the Specification to provide a definition to the term "overlay" used in the claims. Examiner's Answer, page 10. The Examiner in response to those citations appears to assert that the Specification cannot be used to define a term in the claim. Examiner's Answer, pages 10-11. Appellant respectfully traverses. The Specification may be used as a dictionary to learn the meaning of a term in the patent claim. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 U.S.P.Q.2d 1065, 1067 (Fed. Cir. 1999). This is not the same as reading limitations into the claim. Appellant simply cited to the Specification to provide a definition of the term "overlay" which is permissible.

Additionally, the Examiner states:

As indicated in the original specification (page 2, lines 31-33), the definition of 'overlay' is described as 'the annotation file may be displayed as an overlay to the target file, so that the leader can view both the target file, as seen by all users, and the annotation file, which is only seen by the leader.' The examiner notes that 'may be' and 'can view' do not qualify the definition because the annotation file is displayed or is not displayed as

an overlay to the target file. Similarly, the leader can view or can not view both the target file of the overlay and its underneath one. Examiner's Answer, page 11.

Appellant respectfully traverses the assertion that one cannot define a term, namely, overlay, by using terms, such as "may be." The fact that the annotation file may or may not be displayed as an overlay does not change the fact that the definition of overlay may refer to allowing the leader to view both the target file, as seen by all users, and the annotation file, which is only seen by the leader.

Further, Appellant does not understand the Examiner's statement regarding the leader viewing or not viewing both the target file of the overlay and its underneath one. The statement pointed out by the Examiner simply states that the annotation file can be displayed as an overlay to the target file so that the leader can view both the target file and the annotation file. There is no support for the Examiner's construction of the leader viewing or not viewing both the target file of the overlay and its underneath one.

B. Response to Examiner's argument that it would have been obvious to modify Ludwig with Kumar to incorporate the missing claim limitations of claims 3, 5, 7, 17 and 22-24, as discussed on pages 12-13 of Examiner's Answer.

The Examiner asserts that it would have been obvious to modify Ludwig with Kumar to incorporate the missing claim limitations of claims 3, 5, 7, 17 and 22-24 because "both references are directed to a system for electronic-based communication between a plurality of remote users who can simultaneously view and share data in a common work space." Examiner's Answer, page 13. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 3, 5-9, 17, 18 and 22-24.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.*

However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner's motivation ("both references are directed to a system for electronic-based communication between a plurality of remote users who can simultaneously view and share data in a common work space") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Ludwig to include the claim limitations of claims 3, 5, 7, 17 and 22-24. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 3, 5-9, 17, 18 and 22-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, Ludwig addresses the problems inherent in any practical implementation of a scalable collaboration system. Column 2, lines 61-63. The Examiner has not provided any reasons as to why one skilled in the art would modify Ludwig, which teaches allowing a participant controlling another, remote participant involvement in a video conference call (column 1, lines 15-16), to: display the first file on a plural of secondary workstations where the second file is displayed as an overlay to the first file on selected but not all of the plural secondary workstations (missing claim limitation of

claim 3); have the first file and the second file as a single file and where the second file contains a code to indicate that the second file is not for display at the secondary workstation (missing claim limitation of claim 5); have the second file overlaid over the first file using means for coupling the first file and the second file (missing claim limitation of claim 7); have means for overlaying each of the plurality of the third files over the first file on respective ones of the user workstations (missing claim limitation of claim 17); have the first workstation include coupling means to permit the first file and the second file to be displayed on the first workstation (missing claim limitation of claim 22); have the second file displayed as an overlay to the first file on the first workstation and selected of the video displays but less than all of the video displays (missing claim limitation of claim 23); and where the second file contains a code which correlates the second file to the first file (missing claim limitation of claim 24). The Examiner's motivation ("both references are directed to a system for electronic-based communication between a plurality of remote users who can simultaneously view and share data in a common work space") does not provide such reasoning. The Examiner has not explained the connection between the Examiner's motivation and the above-cited missing claim limitations. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Ludwig to include the missing claim limitations of claims 3, 5, 7, 17 and 22-24. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 3, 5-9, 17, 18 and 22-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Furthermore, based on the Examiner's stated motivation ("both references are directed to a system for electronic-based communication between a plurality of remote users who can simultaneously view and share data in a common work space"), the Examiner appears to be in essence asserting that since the references can be combined that it would have been obvious to combine Ludwig with Kumar. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.

In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. §2143.01. Hence, the Examiner's stated motivation is insufficient to support a *prima facie* case of obviousness in rejecting claims 3, 5-9, 17, 18 and 22-24. *Id.*

C. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellant's Appeal Brief and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION

For the reasons stated above and in Appellant's Appeal Brief, Appellant respectfully asserts that the rejections of claims 1-26 are in error. Appellant respectfully requests reversal of the rejections and allowance of claims 1-26.

Respectfully submitted,

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